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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,905	10/20/1998	DENNIS W. HICKS	0142-0317P	7486

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EXAMINER

BASHORE, WILLIAM L

ART UNIT PAPER NUMBER

2176

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/175,905

Applicant(s)

HICKS ET AL.

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-288 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-288 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed 6/7/2002, to the original application filed 10/20/1998, with a provisional filing date of 10/22/1997.
2. The objection to the title of the invention has been withdrawn as necessitated by amendment.
3. The rejection of claims 1-288 under 35 U.S.C. 103(a) as being unpatentable over Suzuki, and Goertz has been withdrawn as necessitated by amendment.
4. Claims 1-288 are pending. Claims 1, 145 are independent claims.

Examiner's Note

5. It is to be noted that Applicant's amendment regarding translating an input data stream significantly changes the scope of the claimed limitations when read as a whole.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (hereinafter Suzuki), U.S. Patent No. 6,213,652 issued April 2001, in view of Goertz et al. (hereinafter Goertz), U.S. Patent No. 6,173,295 issued January 2001, and further in view of Guck, U.S. Patent No. 5,911,776 issued June 1999.

In regard to independent claim 1, Suzuki teaches a system for delivering documents via a network (Suzuki Abstract, column 10 lines 19-23; compare with claim 1 preamble *“a system for delivering documents across a network which comprises:”*).

Suzuki teaches outputting and receiving a data stream in an independent format (PDL) (Suzuki column 3 lines 38-44). Suzuki does not specifically teach translation of an input stream into a stream having a device independent format. However, Guck teaches automatic format conversion of a document into a specific device compatible document via streaming, and a shadow file dedicated to a particular output format. Since a source document can be converted to any device specific format, the document is device independent (Guck Abstract, column 4 lines 40-55, column 5 lines 19-24, column 8 lines 55-67; compare with claim 1 *“a document generator configured to translate....format data stream”*, and *“a computer configured to receive the device independent format data stream”*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Guck to Suzuki, providing Suzuki the benefit of printing to specific printers which will best render a document.

Suzuki does not specifically teach selecting a best output device according to compatible features. However, Goertz teaches a print server whereby a decision is made by said server regarding selection of an appropriate printer able to handle a job request (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claim 1 *“analyze the data stream to determine a best output device by comparing....devices available to the computer”*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Suzuki, because of Goertz's taught advantage of printer selection, providing a user of Suzuki a way to incorporate selection of diverse printer types to accommodate specialized document requirements if necessary.

Suzuki teaches translating print format data to a device specific format, and transmitting said data to a printer (Suzuki Abstract, column 3 lines 38-44, column 10 lines 38-45; compare with claim 1 *“the computer further being programmed to translate the device....to the best output device”*).

Art Unit: 2176

In regard to dependent claim 2, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes, including document data (Suzuki column 45 lines 5-27; compare with claim 2).

In regard to dependent claims 3-4, Suzuki does not specifically teach an affinity value for calculating a best output device. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Suzuki and Goertz, because Goertz teaches appropriate selection from a set of diverse printers in order to process a print job, suggesting a form of comparison/decision making, which incorporates numerical comparison at a coding algorithm level, and providing the advantage of comparing printers to Suzuki (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 3-4).

In regard to dependent claims 5-8, Suzuki teaches a printer job assigned to each printer (Suzuki column 48 lines 60-67; compare with claims 5-8).

In regard to dependent claims 9-12, Suzuki does not specifically teach creation/comparing an affinity value for calculating a best output device. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Suzuki and Goertz, because Goertz teaches appropriate selection from a set of diverse printers in order to process a print job, suggesting a form of comparison/decision making, which incorporates numerical comparison at a coding algorithm level, and providing the advantage of comparing printers to Suzuki (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 9-12).

In regard to dependent claims 13-24, Suzuki teaches a printer job assigned to each printer in a multiple printer network (Suzuki column 48 lines 60-67; compare with claims 13-24).

Art Unit: 2176

In regard to dependent claims 25-36, Suzuki teaches a job ticket comprising various elements (ie. printer name, output-bin-name) to be transmitted to a printer (Suzuki column 45 lines 5-27; compare with claims 25-36).

In regard to dependent claims 37-72, Suzuki teaches a separate system comprising a print processor, a job accepting means, a queuing means, an output means, a converting means, and a conversion control means (Suzuki column 10 lines 19-37; compare with claims 25-72).

In regard to dependent claims 73-144, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes (Suzuki column 45 lines 5-27; compare with claims 73-144).

8. **Claims 145-288 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (hereinafter Suzuki), U.S. Patent No. 6,213,652 issued April 2001, in view of Goertz et al. (hereinafter Goertz), U.S. Patent No. 6,173,295 issued January 2001, and further in view of Guck, U.S. Patent No. 5,911,776 issued June 1999.**

In regard to independent claim 145, Suzuki teaches a system for delivering documents via a network (Suzuki Abstract, column 10 lines 19-23; compare with claim 145 preamble "*a system for delivering documents across a network which comprises:*").

Suzuki teaches outputting and receiving a data stream in an independent format (PDL) (Suzuki column 3 lines 38-44). Suzuki does not specifically teach translation of an input stream into a stream having a device independent format. However, Guck teaches automatic format conversion of a document into a specific device compatible document via streaming, and a shadow file dedicated to a particular

Art Unit: 2176

output format. Since a source document can be converted to any device specific format, the document is device independent (Guck Abstract, column 4 lines 40-55, column 5 lines 19-24, column 8 lines 55-67; compare with claim 145 “*a document generator configured to selectively translate....on selection signals*”, and “*a computer configured to receive the device independent format data stream*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Guck to Suzuki, providing Suzuki the benefit of printing to specific printers which will best render a document.

Suzuki does not specifically teach selecting a best output device according to compatible features. However, Goertz teaches a print server whereby a decision is made by said server regarding selection of an appropriate printer able to handle a job request (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claim 145 “*analyze the data stream to determine a best output device by comparing....devices available to the computer*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Suzuki, because of Goertz’s taught advantage of printer selection, providing a user of Suzuki a way to incorporate selection of diverse printer types to accommodate specialized document requirements if necessary.

Suzuki teaches translating print format data to a device specific format, and transmitting said data to a printer (Suzuki Abstract, column 3 lines 38-44, column 10 lines 38-45; compare with claim 145 “*the computer further being programmed to translate the data stream....to the best output device*”).

In regard to dependent claim 146, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes, including document data (Suzuki column 45 lines 5-27; compare with claim 146).

In regard to dependent claims 147-148, Suzuki does not specifically teach an affinity value for calculating a best output device. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Suzuki and Goertz, because Goertz teaches

Art Unit: 2176

appropriate selection from a set of diverse printers in order to process a print job, suggesting a form of comparison/decision making, which incorporates numerical comparison at a coding algorithm level, and providing the advantage of comparing printers to Suzuki (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 147-148).

In regard to dependent claims 149-152, Suzuki teaches a printer job assigned to each printer (Suzuki column 48 lines 60-67; compare with claims 149-152).

In regard to dependent claims 153-156, Suzuki does not specifically teach creation/comparing an affinity value for calculating a best output device. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Suzuki and Goertz, because Goertz teaches appropriate selection from a set of diverse printers in order to process a print job, suggesting a form of comparison/decision making, which incorporates numerical comparison at a coding algorithm level, and providing the advantage of comparing printers to Suzuki (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 153-156).

In regard to dependent claims 157-168, Suzuki teaches a printer job assigned to each printer in a multiple printer network (Suzuki column 48 lines 60-67; compare with claims 157-168).

In regard to dependent claims 169-180, Suzuki teaches a job ticket comprising various elements (i.e. printer name, output-bin-name) to be transmitted to a printer (Suzuki column 45 lines 5-27; compare with claims 169-180).

In regard to dependent claims 181-216, Suzuki teaches a separate system comprising a print processor, a job accepting means, a queuing means, an output means, a converting means, and a conversion control means (Suzuki column 10 lines 19-37; compare with claims 180-216).

Art Unit: 2176

In regard to dependent claims 217-288, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes (Suzuki column 45 lines 5-27; compare with claims 217-288).

9. **Prior art made of record and not relied upon is considered pertinent to disclosure.**

Rowe et al.	U.S. Patent No. 5,737,599	issued	04-1998
Guck	U.S. Patent No. 5,848,415	issued	12-1998

Gujar, Uday G., A device independent computer plotting system, ACM symposium on Graphic languages, 1976, pages 85-100.

Response to Arguments

10. Applicant's arguments filed 6/7/2002 have been fully and carefully considered but they are not persuasive.

Applicant's arguments on pages 7-9 of the amendment are substantially directed towards amended subject matter. The examiner uses newly applied reference Guck to teach these limitations.

Conclusion

11. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH**

Art Unit: 2176

shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239 (for formal communications intended for entry)

or:

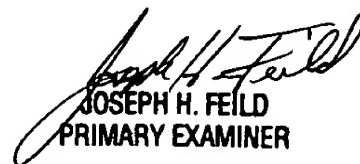
(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).

William L. Bashore
11/01/2002


JOSEPH H. FEILD
PRIMARY EXAMINER